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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,601	02/26/2004	Maximilian Arzberger	P69484US0	2823
7590	12/01/2005		EXAMINER	
Jacobson Holman Professional Limited Liability Company 400 Seventh Street, N.W. Washington, DC 20004-2218			PETRAVICK, MEREDITH C	
		ART UNIT	PAPER NUMBER	
			3671	

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/786,601	ARZBERGER, MAXIMILIAN	
	<b>Examiner</b>	<b>Art Unit</b>	
	Meredith C. Petrvick	3671	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 14 September 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-3,5-11 and 14-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3,5-11 and 14-17 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 9/14/2005 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Drawings***

1. Page 8 of the amendment filed on 9/14/2005 states that a replacement of Figure 1 was filed. However, no replacement drawings were found with the amendment.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
3. Claims 1-3, 5-11 and 14-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant has amended claim 1 to include the limitation that the cutter is used for cutting trenches “of rectangular cross-section” and to includes a third and fourth cutting wheel, which are “arranged in a second pair in rotary manner about a second common rotation axis.” Further claim 1, includes the limitation that the axis of the first pair of cutting wheels and the axis of the second pair of cutting wheels are parallel. Applicant has also added new claim 17, which includes all of the limitations discussed above. The limitations are new matter since they were

not previously disclosed in the original application. Nowhere does the original disclosure mention the shape of the trench.

The original specification merely states that, "at least one cutting wheel" is provided. The drawings and the detailed description show a cutting device with two cutting wheels. The limitation "at least one cutting wheel" does not provide support for a third and fourth cutting wheel. Further, claims 1 and 14 also give detail as to the location of the axis of the third and fourth cutting wheel. This is not disclosed in the original application.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 5-11 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bauer et al. 4,694,915 in view of Smith et al. 4,120,106.

Bauer et al. discloses a trench wall cutter, capable of cutting a rectangular cross-section trench, having four cutting wheels (11) below a frame (5). The cutter wheels are arranged into a first pair and a second pair, each having a common rotation axis. The rotation axes of the first and second pair are parallel (See Figs. 1 and 5). The wheels have cutters (Fig. 1).

However, Bauer et al. does not disclose any of the detail of the cutters nor making the cutters have two cutting elements on a control device so one cutting element removes soil when

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the wheels are rotated in a first direction while the second cutting element is retracted and the second cutting elements removes soil when the cutting wheels are rotated in a direction opposed to the first direction and the first cutting element is retracted.

Like Bauer et al., Smith et al. discloses a soil-cutting device having a rotating cutting wheel (58) with cutters attached. Unlike Edno et al, Smith et al. discloses providing the cutters with two cutting elements (108 and 106). The cutting elements are attached to a control device (60). The first cutting element (108) removes soil when the wheel is rotated in a first direction while the second cutting element (106) is retracted by the control device (6). The opposite happens when the wheel is rotated in a second direction. Smith et al. discloses that this allows the device is cut in multiple directions without wearing out the not used cutting element (Col. 1, line 60 – Col. 2, line 12).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the cutters of Bauer et al. with the cutters of Smith et al., in order to provide for more efficient operation of the device in two directions as suggested in Smith et al.

Regarding claims 2-3 and 5, Smith et al. discloses that the first and second cutting elements are displaceable simultaneously by a force exerted by moving the device against the ground.

Regarding claims 6-8, Smith et al. discloses that the control device is a pivoted lever (60) that has a pivot axis (pivot pin 110) and is symmetrical about the pivot axis (Fig. 4).

Regarding claim 9, Smith et al. discloses that there is a pair of cutting elements on each pivoted lever (Fig. 4).

Regarding claim 10, Smith et al. discloses that the pivoted lever has stops (120, 118).

Regarding claim 11, Smith et al. discloses that the cutting elements have cutting edges (Fig. 4).

Regarding claims 14 and 15, the device in Bauer et al. discloses a frame (5), which is a support plate (Fig. 1) and has bearing plates (13).

Regarding claim 16, any one of the cutting teeth in the combination could be considered as the laterally pivotable hinged teeth, since they are laterally pivotable hinged and capable of removing soil below the bearing plates.

*Response to Arguments*

6. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground of rejection.

The primary reference in the combination above is now Bauer et al. This change was made in response to Applicant's amendment regarding the number of cutting wheels.

*Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Meredith C. Petravick whose telephone number is 571-272-6995. The examiner can normally be reached on M-T 8:00 a.m.- 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will can be reached on 571-272-6998. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Meredith C Petrvick  
Primary Examiner  
Art Unit 3671

November 26, 2005